

In the Figures

Please amend Figure 12 as per the attached sheet.

REMARKS

Claims 1-19 are pending. Claims 20-37 are withdrawn. The specification is being amended. Figure 12 is being amended. Claim 8 is being amended. Claims 23-37 are being canceled without prejudice or disclaimer of the subject matter recited therein. No new matter is being added.

Figure 12 is being amended as per the attached sheet to include labeling as requested in section 3(a) of the Office Action. The subject matter of these labels is supported by the specification and accordingly, does not constitute new matter.

A statement under 37 C.F.R. 1.71(e) is being added to the beginning of the specification as requested in Section 3(b) of the Office Action.

Paragraph 37 has been amended as requested in Section 3(e) of the Office Action.

The text of the specification from page 7, paragraph 0046 to just before paragraph 0049 on page 11 is being amended to increase the line spacing of the computer code as requested in Section 3(c) of the Office Action.

In Section 3(d) of the Office Action, a request is being made to cancel claims 20-37. However, Applicant notes that claims 20-22 depend from an allowable generic claim (independent claim 1). Therefore, Applicant respectfully submits that claim 20-22 should be allowed to issue. Applicant is canceling claims 23-37 without prejudice or disclaimer of the subject matter recited therein.

Claims 1-19 stand objected to under 37 C.F.R. 1.75(a) in that the "body of claim 1 as written does not make a clear reference to "de-embedding."" In regard to this rejection, Applicant respectfully submits that not using the term "de-embedding" in the body of claim 1 does not make the claim indefinite and not cause the claim not to point out and distinctly claim the subject matter which the Applicant regards as the invention.

Applicant respectfully submits that one of skill in the art would understand how the limitations of the body of claim 1 may be utilized in a method for de-embedding a device under test. Applicant respectfully directs the Examiner to paragraph 0002 of the specification as one example of support for this position.

Claim 1 also stands objected in that it "does not particularly point out how exactly the three stated type of parameters are being used to produce the set of device ABCD parameters."

Applicant respectfully submits that claim 1 is not indefinite in that one of ordinary skill would understand the meets and bounds of claim 1. Applicant further notes that

although claims 7 and 8 further describe the using step of claim 1, Applicant is entitled to broader claim coverage than the specific embodiments set forth in those dependent claims. As the Federal Circuit recently stated in Golight Inc. V. Wal-Mart Stores Inc., 355 F3d 1327, 69 USPQ2d 1481 (Fed. Cir. 2004):

The patentees were not required to include within each of their claims all of these advantages or features described as significant or important in the written description. See E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1370 (Fed. Cir. 2003) ("An invention may possess a number of advantages or purposes, and there is no requirement that every claim directed to that invention be limited to encompass all of them."); SRI Int'l, 775 F.2d at 1121 ("If everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims."). 69 USPQ 1484 (Emphasis by Applicant).

Accordingly, claim 1 is not vague or indefinite in that the claims are not required to include all specific aspects of the specification.

Claim 8 has been amended to overcome the objection in Section 3(f).

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned.

If Applicant has overlooked any additional fees, or if any overpayment has been made, the Commissioner is hereby authorized to credit or debit Deposit Account 503079, Freescale Semiconductor, Inc..


SEND CORRESPONDENCE TO:

Freescale Semiconductor, Inc.
Law Department

Customer Number: 23125

Respectfully submitted,

By:



David G. Dolezal
Attorney of Record

Reg. No.: 41,711

Telephone: (512) 996-6839

Fax No.: (512) 996-6854